

REMARKS

Claims **1, 2, 15, 16, and 24-69** are pending in this application. Claims **1, 15, 24, and 47** are independent. We have amended claims **1, 2, 15, and 16**, canceled claims **3-14 and 17-23** without prejudice or disclaimer, and added new claims **24-69**. Reconsideration and further examination of the application is respectfully requested.

Information Disclosure Statements

The Examiner did not consider a published U.S. Patent Application and several Office Actions from a copending patent application that we cited in a previous PTO Form 1449 submitted on November 20, 2008. The Examiner crossed out these references on the PTO Form 1449. The undersigned discussed the situation with the Examiner on at least June 29, 2009. The Examiner indicated that he crossed out the references in question on the PTO Form 1449 because copies of the cited Office Actions were not provided and because the cited published U.S. Patent Application was incorrectly identified and that the Examiner was thus not required to consider these references.

The undersigned thanks the Examiner for his attention to the Information Disclosure Statements that we submitted.

We are filing this Reply with a Request for Continued Examination in order to resolve this issue by submitting an Information Disclosure Statement that cites, among other references, the Office Actions and a correctly identified U.S. Patent Application (Aylmer et al., U.S. Patent Application Publication No. US2003/0212623) that the Examiner did not consider. We will file one or more Information Disclosure Statements shortly and respectfully request that the Examiner consider, and indicate consideration of, all cited references, including those references previously not considered.

Summary of Interviews of July 8, 2009 and November 4, 2009 and Other Discussions

The undersigned spoke with Examiner Araque Jr. several times regarding the present application.

During a telephone discussion with Examiner Araque Jr. on June 29, 2009, the undersigned scheduled an interview with the Examiner.

A telephone interview regarding the present application took place between Examiner Araque Jr. and the undersigned on July 8, 2009. The pertinent portion of the Examiner's summary of the telephone interview (dated July 20, 2009) is presented here as follows:

All participants (applicant, applicant's representative, PTO personnel):

- (1) Gerardo Araque Jr. (3) _____.
(2) Chris Agnew. (4) _____.

Date of Interview: 08 July 2009.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____.

Claim(s) discussed: 1-23.

Identification of prior art discussed: See Continuation Sheet.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Discussed the prior art and its application to the claimed invention. Discussed how the rejection under 35 USC 101 is being applied and possible amendments to overcome the rejection. Applicant's representative will take suggestions provided by the Examiner under consideration and will determine whether and RCE, Continuation, or Appeal will follow..

Continuation of Identification of prior art discussed: Downes (US Patent 6,910,965 B2) in iew of New York Times (<http://query.nytimes.com/gst/fullpage.html?res=9F03E0D81139F93AA15752C0A9659C8B63&partner=rssnyt&emc=rs>) & <http://query.nytimes.com/gst/fullpage.html?res=950DE7D81F31F936A15755C0A96F948260>).

The undersigned generally agrees with the Examiner's summary of the first telephone interview.

In the final Office Action dated January 12, 2009, the Examiner rejected claims **1-14** under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. We do not concede that the previously pending version of these claims were in any way directed to non-statutory subject matter. Nonetheless, with the goal of advancing prosecution toward allowance, the undersigned discussed with the Examiner the prospect of amending the claims to obviate the rejections. The Examiner and the undersigned did not reach agreement on particular amendment language.

In the final Office Action dated January 12, 2009, the Examiner rejected claims **2 and 16** under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. We do not concede that the previously pending versions (nor the amended versions) of claims **2 and 16** are in any way indefinite. The undersigned explained that we respectfully disagree with the indefiniteness rejection maintained by the Examiner in the Office Action and presented arguments to this effect. Agreement was not reached.

In the final Office Action dated January 12, 2009, the Examiner rejected claims 1-23 under 35 U.S.C. § 103(a) over several references, alone or in combination with Office Notice. In the first telephone interview, the undersigned did not, for example, concede (nor do we concede) that the references cited and/or factual assertions used by the Examiner to reject our claims in the final Office Action dated January 12, 2009, alone or in combination, disclose or suggest the subject matter of the previously pending versions of claims **1, 2, 15, and 16**, or of previously pending (now canceled) claims **3-14 and 17-23**. For example, the undersigned briefly explained the undersigned's interpretation of at least Downes, U.S. Patent No. 6,910,965 generally and in relation to, e.g., the previously pending versions of claims **1 and 15**. Nonetheless, with the goal of advancing prosecution toward allowance, the undersigned discussed the prospect of amending the claims with the Examiner.

During a subsequent telephone discussion with Examiner Araque Jr. on October 28, 2009, the undersigned scheduled a second interview with the Examiner.

A second telephone interview regarding the present application took place between Examiner Araque Jr., Supervisory Patent Examiner Janice A. Mooneyham, and the undersigned on November 4, 2009. The undersigned faxed a copy of proposed claim amendments to Examiner Araque Jr. A copy of the fax and the amendments was attached to the Examiner's Interview Summary, dated November 9, 2009. The pertinent portion of the Examiner's summary of the telephone interview (dated November 9, 2009) is presented here as follows:

All participants (applicant, applicant's representative, PTO personnel):

(1) Gerardo Araque Jr.

(3) Christopher Agnew.

(2) Janice Mooneyham.

(4) _____.

Date of Interview: 04 November 2009.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: _____.

Claim(s) discussed: 1-23.

Identification of prior art discussed: Downes (US Patent 6,910,965 B2) in view of New York Times NPL Reference and Official Notice.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Discussed how and why the Official Notice is being maintained as well as amendments to better clarify the claimed invention as well as properly traversing the Official Notice Rejection.

The undersigned generally agrees with the Examiner's summary of the second telephone interview.

In the second telephone interview, the undersigned briefly discussed with the Examiners proposed amendment language intended to obviate the rejections under 35 U.S.C. § 101. No specific agreement was reached.

The rejections under 35 U.S.C. § 112 were not discussed.

The undersigned also generally discussed with the Examiners proposed amendment language intended to obviate the rejections under 35 U.S.C. § 103. No specific agreement was reached.

The undersigned also discussed the Examiner's use of Official Notice in, e.g., the final Office Action dated January 12, 2009. The undersigned explained our contention that previous traverses of Official Notice were in no way inadequate and that we have not admitted any subject matter is prior art. No specific agreement was reached.

The undersigned emphasized numerous times in the interview to both Examiner Araque Jr. and to Supervisory Patent Examiner Mooneyham that the previously pending claims in the application could proceed to appeal, but that we are attempting to move the case toward allowance, while still maintaining the scope of the independent claims should an appeal be warranted.

We do not necessarily agree with or acquiesce in any characterization of any claim term or rejection of any claim that Examiner Araque Jr. may have made in the Interview Summaries or during the pendency of the present patent application.

The undersigned greatly appreciates Examiner Araque Jr.'s time in speaking with the undersigned regarding the present application and for granting multiple interviews after the final Office Action. The undersigned also appreciates speaking with Supervisory Patent Examiner Mooneyham regarding the present application during the second interview.

Examiner Araque Jr. is strongly encouraged to telephone our undersigned representative, **Christopher Agnew, at (857) 413-2050** with any suggestions to advance prosecution and/or to resolve any condition that would impede allowance. Depending on the circumstances and not necessarily for reasons of patentability, we are willing to consider claim amendments and/or claim cancellations if such amendments and/or cancellations will, in our judgment, advance prosecution toward an earlier allowance and/or satisfy our current business objectives.

Claim Amendments

We do not necessarily agree with the propriety of or concede any of the arguments in the final Office Action dated January 12, 2009 ("Office Action"). Nor do we concede that the Examiner made *prima facie* showings for the rejections in the Office Action.

Nonetheless, to advance prosecution and obtain early issuance of some subject matter in early next year rather than forgo the issuance of any subject matter at all early next year, we have amended claims **1, 2, 15, and 16**, canceled claims **3-14 and 17-23** without prejudice or disclaimer, and added new claims **24-69**. We respectfully request reconsideration and withdrawal of the rejections and further examination of the application.

We have amended claims **1, 2, 15, and 16** and have left these claims pending in order to preserve our right to appeal should we be inclined to file an appeal after, e.g., receiving an Office Action following this Reply.

We in no way concede that the previously pending versions of, e.g., independent claims **1** and **15** were in any way directed to non-statutory subject matter. For example, previously pending independent claim **15** was directed to a system and was not rejected under 35 U.S.C. § 101. Nonetheless, to advance prosecution, obtain early issuance, and to place the claims in

condition for a potential appeal, we have amended independent claims **1 and 15** and respectfully submit that these claims are directed to statutory subject matter.

We reserve the right to file any of, e.g., the previously pending versions of claims **1, 2, 15, and 16** and the canceled claims **3-14 and 17-23** in, e.g., one or more continuing applications.

Claim Rejections - 35 U.S.C. § 101

In the Office Action, the Examiner rejected claims **1-14** under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter.

We do not concede that the previously pending versions of claims **1-14** were in any way directed to non-statutory subject matter. Nor do we concede that the Examiner made a *prima facie* showing for the rejections under 35 U.S.C. § 101 in the Office Action.

Nonetheless, to advance prosecution, obtain early issuance of some subject matter in early next year rather than forgo the issuance of any subject matter at all in early next year, and to place the claims in condition for a potential appeal, we have amended independent claim **1** and dependent claim **2**, and have canceled claims **3-14** without prejudice or disclaimer.

Accordingly, we respectfully request reconsideration and withdrawal of the rejections.

Claim Rejections - 35 U.S.C. § 112

In the Office Action, the Examiner rejected claims **2 and 16** under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

We do not concede that the previously pending versions (or the amended versions) of claims **2 and 16** are in any way indefinite. Nor do we concede that the Examiner made a *prima facie* showing that the previously pending versions of claims **2 and 16** failed to comply with the definiteness requirement of 35 U.S.C. § 112.

We respectfully submit that the indefiniteness rejection of the previously pending versions of claims **2 and 16** is improper for at least the reasons presented in Applicants' Reply Pursuant to 37 C.F.R. §1.111, dated October 14, 2008, at page 8.

The Examiner argued in the Office Action "that the language of the claim continues to be unclear because one of ordinary skill in the art would not be capable of determining when there is an infringement of the claim. In other words, one of ordinary skill in the art would not be able to determine if they are infringing upon the claim if they are conducting a wager/bet using point

spread, over/under, or spread."¹ We respectfully disagree that the previously pending versions (or the amended versions) of claims 2 and 16 are in any way unclear. Claim 2 requires, among other things, that "wherein ... the first bet comprises a bet that the total number of units earned by the participant will be greater than the upper index number" and that "receiving ... a second bet that the total number of units earned by the participant will be less than the lower index number." This claim language is clear on its face and we respectfully submit that we are under no obligation to amend the claims in the manner that the Examiner appears to suggest.

Moreover, we have added new claims **24-69** and, particularly new independent claims **24 and 47** include language that obviates any rejection under 35 U.S.C. § 112, second paragraph.

Accordingly, we respectfully request reconsideration and withdrawal of the rejections.

Claim Rejections - 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims **1, 3-5, 9, 11-15, 20, 22, and 23** under 35 U.S.C. § 103(a)² as allegedly being unpatentable over Downes, U.S. Patent No. 6,910,965 ("**Downes**") in view of New York Times, "HORSE RACING; Purse May Rise For Super Derby" ("**New York Times I**") and New York Times, "PLUS: AUTO RACING; Winston Cup Purse Increased by Nascar." ("**New York Times II**"). In the Office Action, the Examiner also rejected claims **2, 6, 7, 8, 10, 16-19, and 21** under 35 U.S.C. § 103(a)³ as allegedly being unpatentable over **Downes** in view of **New York Times I** and **New York Times II** and further in view of Official Notice." In the Office Action, the Examiner further contends that our previous counsel

¹ Office Action, dated January 12, 2009, at page 12.

² In the Office Action, the Examiner referenced "35 U.S.C. § 102(e)" and "anticipat[ion]" of the claims. Office Action, dated January 12, 2009, at pages 4 and 9. Nonetheless, in our view, at least the heading of the rejections ("Claim Rejections - 35 U.S.C. § 103"), the form paragraph at page 4, paragraph 7, and the combinations of references and factual assertions indicate that any references to, e.g., "35 U.S.C. § 102(e)" were inadvertent and that the Examiner intended an obviousness rejection under 35 U.S.C. § 103. *Id.*, at, e.g., page 4, 12. Accordingly, we have not addressed "anticipat[ion]" issues but will note respectfully for the record that any rejections in the Office Action are clearly improper 35 U.S.C. § 102(e) rejections.

³ See previous footnote.

allegedly made an inadequate traverse of Official Notice used in rejections in a previous Office Action.⁴

We do not necessarily agree with or concede any of the arguments in the Office Action regarding, e.g., Downes, New York Times I, New York Times II, alleged "admitted prior art," and/or various factual assertions (including Official Notice). Nor do we concede that the Examiner made a *prima facie* showing that previously pending claims **1-23** were obvious, i.e., unpatentable under 35 U.S.C. § 103(a).

For example, we respectfully submit that the obviousness rejections of the previously pending versions of (now amended) claims **1, 2, 15, and 16** and previously pending (now canceled) claims **3-14 and 17-23** are improper for at least the reasons presented in Applicants' Reply Pursuant to 37 C.F.R. §1.111, dated October 14, 2008, at pages 8-13.

Nonetheless, to advance prosecution and obtain early issuance of some subject matter in early next year rather than forgo the issuance of any subject matter at all early next year, we have amended claims **1, 2, 15, and 16** and canceled claims **3-14 and 17-23** without prejudice or disclaimer, and have added new claims **24-69**. We respectfully request reconsideration and withdrawal of the rejections.

Comment Regarding Official Notice and/or Various Factual Assertions

In the Office Action, the Examiner further contends that our previous counsel allegedly made an inadequate traverse of Official Notice used in rejections in a previous Office Action.⁵ We respectfully disagree that the previous traverses of various rejections (see, e.g., Applicants' Reply Pursuant to 37 C.F.R. §1.111, dated October 14, 2008, at pages 11-13) were in any way inadequate. We respectfully disagree that we have conceded that anything is "admitted prior art" and maintain our traverses of Official Notice.

Notwithstanding the Examiner's comments at pages 15-16 of the Office Action, for purposes of the record, we respectfully submit that all factual findings of the Patent and Trademark Office must be supported by substantial evidence. *In re Zurko*, 258 F.3d 1379, 1383-84 and 86 (Fed. Cir. 2001) ("Obviousness is a legal question based on underlying factual

⁴ Office Action, dated January 12, 2009, at pages 15-16.

⁵ Office Action, dated January 12, 2009, at pages 15-16.

determinations.... We review factual findings underlying [the legal determination of obviousness] for substantial evidence.” “With respect to core factual findings in a determination of patentability, the Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”); *Novamedix Distrib. Ltd. v. Dickinson*, 175 F. Supp. 2d 8, 9 (D.D.C. 2001) (In a determination of obviousness, “factual findings as to scope and content of the prior art, level of ordinary skill in the art, differences between the claimed invention and the prior art, and secondary considerations of nonobviousness must be upheld if supported by substantial evidence.”); MPEP § 2144.03(A) (“It is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.”).

Because the Examiner’s rejections that are based on Officially Noticed subject matter (and allegedly admitted Applicant prior art) and/or various factual assertions lack substantial evidence support, the rejections are insufficient to establish a *prima facie* case of obviousness.

Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

We believe that the application is in condition for allowance, which action is respectfully requested at the Examiner’s earliest convenience.

Comment Regarding Claim Amendments

None of the statements below is intended to be an addition to or alteration of the written description of the application as filed. None of the statements below is a statement of what is or is not included in the written description of the application as filed.

In responding to this Office Action, we have made several amendments. We wish to make clear in amending the claims that, unless otherwise noted, "a," "an," or "the" means "one or more" and/or "at least one." For example, "an X" means "one or more X," and/or "at least one X."

Unless otherwise noted, "at least one of X, Y, and Z" is intended to be broad enough to include any of the following (and/or any unstated combination of the following): "only X," "only Y," "only Z," "one or more X," "one or more Y," "one or more Z," "only X and Y," "only X and Z," "only Y and Z," "one or more X and one or more Y," "one or more X and one or more Z," "one or more Y and one or more Z," "only X, Y, and Z," and "one or more X and one or more Y and one or more Z."

Unless otherwise noted, "based on" means "based at least in part on" or "based at least on."

Authorization for Email Communication

Recognizing that Internet communications are not secure, we hereby authorize the USPTO to communicate with any authorized representative concerning any subject matter of this application by electronic mail. We understand that a copy of these communications will be made of record in the application file.

General Authorization for All Fees During Pendency of this Application

For the entire pendency of the application, the Commissioner of Patents is hereby authorized to charge all fees, or credit any overpayment, to our Deposit Account No. 50-3938.

The Examiner is strongly encouraged to telephone our undersigned representative, Christopher Agnew, at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, we petition for any extension of time required to make this response timely and otherwise not present. Kindly charge any additional fee, or credit any surplus due for any reason, to Deposit Account No. 50-3938.

Respectfully submitted,

Dated: December 14, 2009

By: /Christopher D. Agnew/
Christopher D. Agnew
Reg. No. 43,464
cagnew@cantor.com
(857) 413-2050

Customer No: 63710